

## **REMARKS**

By this amendment, the title, abstract, and claims 1 and 3-14 have been amended. Claims 1-14 remain in the application. Support for the amendments to the claims can be found the specification and drawings. No new matter has been added. Reconsideration, and allowance of the application, as amended, is respectfully requested.

### **Objection to the Specification**

The title of the application stands objected to as being not descriptive. By this amendment, the title has been amended to be more clearly indicative of the subject matter to which the claims are directed. Accordingly, the objection to the title has been overcome and should be withdrawn.

The abstract of the disclosure stands objected to because it does not commence on a separate sheet. By this amendment, the abstract has been replaced and presented on a separate sheet. Accordingly, the objection to the specification has been overcome and should be withdrawn.

### **Objection to the Claims**

Claims 3, 11-14 stand objected to because of informalities. By this amendment claims 3 and 11-14 have been amended to clarify the same. In particular, claim 3 is an independent claim and claims 11-14 are dependent claims.

In addition, claims 1 and 3-14 have been amended to remove element numbers from the claims.

Accordingly, the objection of the claims has been overcome and should be withdrawn.

**Rejection under 35 U.S.C. §103**

Claim 1 recites a method for measuring a switched current which is periodically switched on and off with use of a switch, and providing a measuring signal accurately reflecting said switched current, the method comprising:

sensing said switched current with a current sensor to obtain an intermediate measuring signal corresponding to an AC part of said switched current, wherein the current sensor includes an AC current transformer having a primary winding coupled in series with the switch, the AC current transformer further having a secondary winding for providing the intermediate measuring signal;

receiving a timing signal indicating the on and off periods of the switched current;

during an off period of the switch, generating an auxiliary signal such that the sum of said intermediate measuring signal and said auxiliary signal is equal to zero; and

during an on period of the switch, adding said intermediate measuring signal that was generated during the off period and said auxiliary signal and providing the sum signal as the measuring signal of the switched current.

Support for the amendments to claim 1 (as well as for amendments to claim 3, 4 and 11), can be found in the specification at least on page 4, lines 26-33; and page 5, lines 1-2 and 22-29.

Claims 1-4, 7-11, 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **Lethellier** (USPAT 6,441,597) in view of **Schetelig et al.** (USPAT 6,895,229). With respect to claim 1, Applicant respectfully traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 1.

As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for at least the following, mutually exclusive, reasons.

**1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

The **Lethellier** and **Schetelig** references cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

*A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Lethellier** nor **Schetelig** teaches "... sensing said switched current with a current sensor [that] ... includes an AC current transformer having a primary winding coupled in series with the switch [and] ... a secondary winding for *providing* the intermediate measuring signal [and] ... during an off period ... generating *an auxiliary signal* such that the *sum* of said intermediate measuring signal and said auxiliary signal is *equal to zero* ... **and** ... during an on period ... adding said intermediate measuring signal *that was generated during the off period* and said auxiliary signal and providing the sum signal ..." as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit

terms of the statute cannot be met.

Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

## 2. The Combination of References is Improper

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why the **Lethellier** and **Schetelig** cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

*...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, neither **Lethellier** nor **Schetelig** teaches, or even suggests, the desirability of the combination since neither teaches the specific steps that include "... sensing said switched current with a current sensor [that] ... includes an AC current transformer having a primary winding coupled in series with the switch [and] ... a secondary winding for providing the intermediate measuring signal [and] ... during an off period ... generating *an auxiliary signal* such that the *sum* of said intermediate measuring signal and said auxiliary signal is *equal to zero* ... **and** ... during an on period ... adding said intermediate measuring signal *that was generated during the off period* and said auxiliary signal and providing the sum signal ..." as specified above and as claimed in claim 1.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Dependent claim 2 depends from and further limits independent claim 1 and therefore is allowable as well. The 35 U.S.C. § 103(a) rejection thereof has now been overcome.

By this amendment, claim 3 has been amended in a similar manner as with respect to the amendments to claim 1. Accordingly, claim 3 is believed allowable for at least the same reasons as those presented herein above with respect to overcoming the rejection of claim 1. The 35 U.S.C. § 103(a) rejection thereof has now been overcome.

By this amendment, claim 4 has been amended in a similar manner as with respect to the amendments to claim 1. Accordingly, claim 4 is believed allowable for at least the same reasons as those presented herein above with respect to overcoming the rejection of claim 1. Dependent claims 7-10 depend from and further limit independent claim 4 and therefore is allowable as well. The 35 U.S.C. §103(a) rejection has now been overcome.

By this amendment, claim 11 has been amended in a similar manner as with respect to the amendments to claim 4. Accordingly, claim 11 is believed allowable for at least the same reasons as those presented herein above with respect to overcoming the rejection of claim 4. The 35 U.S.C. § 103(a) rejection thereof has now been overcome. Dependent claims 12-14 depend from and further limit independent claim 11 and therefore is allowable as well. The 35 U.S.C. §103(a) rejection has now been overcome.

Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **Lethellier** in view of **Akamatsu et al.** (USPAT 4,298,838). With respect to claims 5 and 6, Applicant respectfully traverses this rejection for at least the following reason. Dependent claims 5 and 6 depend from and further limit independent claim 4 and therefore are allowable as well. The 35 U.S.C. §103(a) rejection has now been overcome.

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over **Lethellier** in view of **Kushida et al.** (US 2002/0185987). With respect to claim 12, Applicant respectfully traverses this rejection for at least the following reason. Dependent claim 12 depends from and further limits independent claim 11 and therefore is allowable as well. The 35 U.S.C. §103(a) rejection has now been overcome.

### **Conclusion**

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1, 3, 4 and 11 are in condition for allowance. Dependent claims (2), (5-10), and (12-14) depend from and further limit independent claims 1, 4, and 11, respectively, and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 1-14 is requested.

Respectfully submitted,

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